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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,912	08/16/2001	Jeffrey L. Anderson	CM-006B	1698

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,912

Applicant(s)

ANDERSON ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other: _____

Art Unit: 1712

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-41, drawn to the reaction product of addition polymer A and polymer B, optionally with crosslinking agent (ii) and/or epoxy resin (iv) (claims 22-31), classified in class 525, subclass 170.
- II. Claims 42-51, drawn to a method of preparing an acrylic epoxy hybrid powder coating comprising mixing the reaction product of addition polymer A and polymer B with an epoxy resin (ii) and an acrylic resin (iii), classified in class 525, subclass 108.

Invention I is distinct from Invention II because the method of Invention II involves a chemically diverse blend further containing acrylic resin (iii) which confers materially different physical properties to the powder coating obtained via the method.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

1) Addition polymers A such as the styrene/ α -methylstyrene/acrylic acid copolymer prepared in paragraph 50 on page 16 of the specification.

2) Polymers B such as the polyester obtained in paragraph 54 on page 19 wherein the reactive functional groups are identified (e.g. hydroxyl groups).

Contingent upon the election of Invention I:

Items 1) and 2) hereinabove and

3) The presence or absence of the crosslinking agent (ii) of claims 22-31 wherein if its presence is elected, a particular species thereof is identified such as the Jeffamine ED 600[®] shown in Table B on page 29.

4) The presence or absence of the epoxy resin (iv) of claims 22-31 wherein if its presence is elected, a particular species thereof is identified such as Epon 836[®] employed in Table B.

Contingent upon the election of Invention II:

Items 1) and 2) hereinabove and

5) Epoxy resins (ii) such as Epon 836[®] employed in Table B.

6) Acrylic resins (iii) such as Joncryl 569 wherein the monomers constituting the tradename are identified.

Art Unit: 1712

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within items 1) and 2), and appropriate items 3) to 6) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-51 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

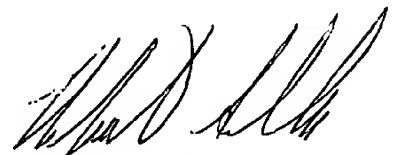
Art Unit: 1712

A telephone call was made to Bill Maheras on March 5, 2003 to request an oral election to the above restriction and election of species requirements, but did not result in an election being made. The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143).

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Why is the polymeric composition characterized as "**essentially**" non-gelled in claim 1, line 7 as opposed to its denotation as "**substantially**" non-gelled in claim 11, line 8 [emphasis added]? Where are the parameters of "essentially" and "substantially" described in the specification? At what threshold maximum of gellation are the terms "substantially" and "essentially" satisfied?

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Robert Sellers
Primary Examiner
Art Unit 1712

rs
3/5/03